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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,564	08/16/2006	Hiroshi Asada	04173.0522	9485
22852	7590	11/10/2009	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			CLAWSON, STEPHEN J	
			ART UNIT	PAPER NUMBER
			2461	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/589,564

Applicant(s)

ASADA ET AL.

Examiner

STEPHEN J. CLAWSON

Art Unit

2461

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9-12 is/are rejected.
- 7) ☒ Claim(s) 5-8 and 13-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/808)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 3, 9, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Yarlagadda (US Pat. 7,095,733).

Regarding claim 1, Yarlagadda discloses a voice mail device comprising:

a receiving section (**See Yarlagadda fig. 2, '201', col. 3, lines 46-48; VoIP system (i.e. receiving section) receives VoIP packets from the Internet.)** which receives from a first telephone terminal (**See Yarlagadda fig. 2 Web (PC, VoIP) (i.e. first telephone terminal)**) The Web/PC acts as a telephone terminal by allowing

VoIP packets to be sent and received.) an audio packet including audio data in a first encoding format; **(See Yarlagada fig. 7, S700 ‘receive a call over VoIP network (i.e. audio packets including audio data)’; VoIP network using CODEC format G723.1 (col. 1, lines 41-42, fig. 2))**

a packet storing section which stores the audio packet including the audio data in the first encoding format received by said receiving section; and **(See Yarlagada col. 4, lines 14-15; Message Access Server (MAS) (i.e. packet storing section) stores voice data (i.e. audio packet including the audio data) in native VoIP format (G723.1) (See col. 3, line 48-50))**

a transmitting section **(See Yarlagadda fig. 2, ‘201’, col. 3, lines 46-48; VoIP system (i.e. transmitting section (VoIP system can act as both a transmitting and receiving section because it provides connectivity and performs both transmitting and receiving.) transmits VoIP packets to the PSTN, gateways and ultimately the phones on the other end of the call.) which transmits to a second telephone terminal the audio packet stored in said packet storing section. (See Yarlagadda fig. 2; VoIP system ‘201’ transmits VoIP packets (i.e. audio packets stored in storing section (i.e. MAS)) to the PSTN, gateways and ultimately the phones (i.e. second telephone) on the other end of the call.)**

Regarding claim 3, Yarlagadda discloses the voice mail device as set forth in claim 1, further comprising:

an encoding format determining section which communicates with the second telephone terminal to determine an encoding format of audio data; and **(See Yarlagadda fig. 2; '202' Gateway (i.e. encoding format determining section) determines the encoding format of the PSTN network and phone (i.e. second telephone terminal) connected thereto.)**

a transcoding section which transcodes the audio data included in the audio packet stored in said packet storing section, based on the determination by said encoding format determining section. **(See Yarlagadda fig. 2; '202' Gateway (i.e. transcoding section (a gateway can act as a format determining section and transcoding section because it performs both functions)) connects the PSTN to a VoIP network and encode voice data in G.723.1 format. (See col. 3, lines 40-43) It logically follows that the VoIP packets of voice data encoded in G.723.1 would have to be decoded to be sent across the PSTN.)**

Regarding claim 9, Yarlagadda discloses a voice mail communication method, comprising:

receiving from a first telephone terminal **(See Yarlagadda fig. 2 Web (PC, VoIP) (i.e. first telephone terminal) The Web/PC acts as a telephone terminal by allowing VoIP packets to be sent and received.)** an audio packet including audio data in a first encoding format; **(See Yarlagadda fig. 7, S700 'receive a call over VoIP network (i.e. audio packets including audio data)'; VoIP network using CODEC format G723.1 (col. 1, lines 41-42, fig. 2))**

storing the received audio packet including the audio data in the first encoding format; and **(See Yarlagadda col. 4, lines 14-15; Message Access Server (MAS) (i.e. packet storing section) stores voice data (i.e. audio packet including the audio data) in native VoIP format (G723.1) (See col. 3, line 48-50))**

transmitting the stored audio packet to a second telephone terminal. **(See Yarlagadda fig. 2; VoIP system '201' transmits VoIP packets (i.e. audio packets stored in storing section (i.e. MAS)) to the PSTN, gateways and ultimately the phones (i.e. second telephone) on the other end of the call.)**

Regarding claim 11, Yarlagadda discloses the voice mail communication method as set forth in claim 9, further comprising:

communicating with the second telephone terminal to determine an encoding format of audio data; and **(See Yarlagadda fig. 2; '202' Gateway (i.e. encoding format determining section) determines the encoding format of the PSTN network and phone (i.e. second telephone terminal) connected thereto.)**

transcoding the audio data included in the stored audio packet, based on the determined encoding format. **(See Yarlagadda fig. 2; '202' Gateway (i.e. transcoding section (a gateway can act as a format determining section and transcoding section because it performs both functions)) connects the PSTN to a VoIP network and encode voice data in G.723.1 format. (See col. 3, lines 40-43) It logically follows that the VoIP packets of voice data encoded in G.723.1 would have to be decoded to be sent across the PSTN.)**

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yarlagadda (US Pat. 7,095,733), and further in view of Oh (US Pat. 7,251,480).

Regarding claim 2, Yarlagadda discloses the voice mail device as set forth in claim 1. Yarlagadda does not explicitly disclose further comprising an encoding format determining section which communicates with the second telephone terminal to determine an encoding format of audio data, wherein said transmitting section transmits to the second telephone terminal the stored audio packet when the determined encoding format is the first encoding format. However, Oh does disclose an encoding format determining section which communicates with the second telephone terminal to determine an encoding format of audio data, wherein said transmitting section transmits to the second telephone terminal the stored audio packet when the determined encoding format is the first encoding format. **(See Oh fig. 4, '206', '212', '214'; A voice mail message is encoded and if it's recipient (i.e. second telephone terminal) is a mobile station then it bypasses the transcoder (i.e. if the audio packet is in the first encoding format then it is saved in this format for the second**

mobile telephone to retrieve) Therefore, the system knows the encoding format of the second device based upon whether it is a mobile phone or not and thus a BSC (Base station controller) would determine whether a device is a mobile device or not based upon its connectivity to the BSC.) Therefore it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to modify the system of Yarlagadda to include the teaching of a format determining section which communicates with the second telephone terminal to determine an encoding format of audio data by Oh with the motivation being to efficiently transmit data that is encoded so as to optimize performance and eliminate needless and inefficient transcoding of packets.

Regarding claim 10, Yarlagadda discloses the voice mail communication method as set forth in claim 9. Yarlagadda does not explicitly disclose communicating with the second telephone terminal to determine an encoding format of audio data, wherein the stored audio packet is transmitted to the second telephone terminal when the determined encoding format is the first encoding format. However, Oh does disclose communicating with the second telephone terminal to determine an encoding format of audio data, wherein the stored audio packet is transmitted to the second telephone terminal when the determined encoding format is the first encoding format. **(See Oh fig. 4, '206', '212', '214'; A voice mail message is encoded and if it's recipient (i.e. second telephone terminal) is a mobile station then it bypasses the transcoder (i.e. if the audio packet is in the first encoding format then it is saved in this**

format for the second mobile telephone to retrieve) Therefore, the system knows the encoding format of the second device based upon whether it is a mobile phone or not and thus a BSC (Base station controller) would determine whether a device is a mobile device or not based upon its connectivity to the BSC.)

Therefore it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to modify the system of Yarlagadda to include the teaching of a format determining section which communicates with the second telephone terminal to determine an encoding format of audio data by Oh with the motivation being to efficiently transmit data that is encoded so as to optimize performance and eliminate needless and inefficient transcoding of packets.

5. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yarlagadda (US Pat. 7,095,733).

Regarding claim 4, Yarlagadda discloses the voice mail device as set forth in claim 3, further comprising:

a packet converting section which converts the transcoded audio data stored in said transcoded audio storing section to an audio packet; and **(See Yarlagadda col. 3, lines 40-43; Gateways connect the PSTN to a VoIP network and encode (i.e. transcode) voice data in G.723.1 format is encapsulated in IP packets. It logically follows that the reverse process occurs to transmit voice data from a PSTN telephone through a VoIP. Therefore, the IP packets containing G.723.1 formatted**

voice data (i.e. audio data) is converted to PCM (See fig. 1) (i.e. audio packet) to be sent over the PSTN.)

a packet transmitting section which transmits to the second telephone terminal the audio packet resulting from the conversion by said packet converting section. **(See Yarlagadda fig. 2; GW (i.e. packet transmitting section) transmits to the pictured telephone (i.e. second telephone terminal) the audio packet)**

Yarlagadda does not explicitly disclose a transcoded audio storing section which stores audio data transcoded by said transcoding section. However, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that a Gateway would contain memory, cache, or a buffer in order to operate and this memory, cache, or buffer could be interpreted as a storing section.

Regarding claim 12, Yarlagadda discloses the voice mail communication method as set forth in claim 11, further comprising:

converting the stored transcoded audio data to an audio packet; and **(See Yarlagadda col. 3, lines 40-43; Gateways connect the PSTN to a VoIP network and encode (i.e. transcode) voice data in G.723.1 format is encapsulated in IP packets. It logically follows that the reverse process occurs to transmit voice data from a PSTN telephone through a VoIP. Therefore, the IP packets containing G.723.1 formatted voice data (i.e. audio data) is converted to PCM (See fig. 1) (i.e. audio packet) to be sent over the PSTN.)**

transmitting the audio packet resulting from the conversion to the second telephone terminal. **(See Yarlagadda fig. 2; GW (i.e. packet transmitting section) transmits to the pictured telephone (i.e. second telephone terminal) the audio packet)**

Yarlagadda does not explicitly disclose storing the transcoded audio data. However, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that a gateway would contain memory, cache, or a buffer in order to operate and this memory, cache, or buffer could be interpreted as storing.

Allowable Subject Matter

6. Claims 5-8 and 13-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEPHEN J. CLAWSON whose telephone number is (571)270-7498. The examiner can normally be reached on M-F 7:30-5:00 pm est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/STEPHEN J. CLAWSON/
Examiner, Art Unit 2461

/Huy D Vu/
Supervisory Patent Examiner, Art Unit 2461